

## **REMARKS**

Claims 1-20 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Section 103(a) Rejections:**

The Office Action rejected claims 1, 2, 5, 7, 8, 13-15, 19 and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Harrell et al. (U.S. Publication 2002/0156656) (hereinafter “Harrell”) in view of www.pipinsure.com (<http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html>) (hereinafter “Pipinsure”) in further view of Welles (U.S. Patent 5,686,888), claims 1, 4, 6, 9-12, 16 and 17 as allegedly being unpatentable over Harrell in view of Pipinsure and Welles and further in view of Bennett et al. (U.S. Patent 7,117,170) (hereinafter “Bennett”), and claims 1 and 18 as allegedly being unpatentable over Harrell and Pipinsure and Welles and further in view of Kepler (U.S. Patent 5,347,845) (hereinafter “Kepler”). Applicant traverses the rejections for at least the following reasons.

### **Claim 1 – Harrell in view of Pipinsure in further view of Welles**

**1. The cited art fails to teach or suggest the generation of the specific type of data file claimed and the inclusion of such a data file within a memory device that accompanies an item during shipment.**

More specifically, the cited art fails to teach or suggest *i) generating a data file comprising at least the following item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment, and ii) storing the data file in a memory device that accompanies the item during said shipment*, as recited in claim 1. The Office

cites the teachings of Harrell, Pipinsure, and Welles, none of which teach or suggest these aspects of Applicant's claim, as described in more detail below.

Harrell teaches a storage media and method for selling cargo insurance in a network environment (e.g., "online") (Harrell, Abstract). According to the Harrell reference, a user seeking insurance for cargo can provide data as part of a quotation process (Harrell, Paragraph [0043]). This data may include information "regarding commodity, departure and arrival locations, mode of conveyance, estimated departure date, invoice value, amount of insured and currency" (Harrell, Paragraph [0043]). The Office appears to consider this data as being equivalent to "item information including one or more characteristics of the item" as recited in Applicant's claim. Presumably this data is received by Harrell's "all encompassing cargo insurance system" (Harrell, Paragraph [0032]) since such system performs "calculation[s]" based on the data (Harrell, Paragraph [0043]).

In regard to "insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment," the Office cites various portions of Harrell including paragraph [0048]; Figures 2, 4, and 5; and Tables 3, 4, 9, and 10. Office Action of December 7, 2010, page 3. However, a primary purpose of these portions of Harrell is to support the issuance of both electronic and physical insurance certificates to a customer. Harrell, even when considered in light of the other cited references, fails to teach or suggest anything about actually *generating a data file comprising at least the following item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment, and ii) storing the data file in a memory device that accompanies the item during said shipment*, as recited in claim 1. **Instead, Harrell describes collecting information from a customer and using that information to issue an insurance certificate to a customer, not storing the certificate (much less the specific data file claimed) in a memory device that accompanies a respective insured item during**

shipment. Furthermore, while Harrell does teach the generation of an electronic insurance certificate, Harrell never actually specifies what the insurance certificate includes. Accordingly, providing this nondescript insurance certificate to a customer is clearly not commensurate with storing the specific type of data file claimed, much less storing such data file within a memory device that accompanies the insured item during shipment.

Moreover, while it appears that Harrell's "all encompassing cargo insurance system" has some sort of *access* to information "regarding commodity, departure and arrival locations, mode of conveyance, estimated departure date, invoice value, amount of insured and currency" (Harrell, Paragraph [0043]) as well as *access* to "terms and conditions of the contract" (Harrell, Paragraph [0048]), Harrell does not provide any specific information as to where such information resides or how such information is stored within a computer. **More specifically, at no point does Harrell (even when considered with Pipinsure and Welles) teach or suggest "storing [a] data file [that comprises both the item information and the insurer information] in a memory device that accompanies the item during said shipment."** The Office has failed to provide any evidence of record that teaches this *specific* type of data file stored within a memory device that accompanies the insured item during shipment. Welles and Pipinsure fail to overcome the deficiencies of Harrell described above.

Presumably to overcome the deficiencies of Harrell, the Office cites the teachings of Welles (as well as Pipinsure). Welles teaches a system that utilizes sensor to monitor cargo being shipped. For instance, Welles teaches:

The condition and/or integrity of goods is monitored while in transit using a local area network of tracked assets. Autonomous electronic sensors are situated in proximity to the cargo being shipped. These sensors communicate with an asset tracking unit affixed to the container for the goods via a matter mode transceiver. The tracking unit has the ability to relay the cargo sensor data to the central station on demand, on exception, or on a predetermined schedule established by the central station. Communication between the cargo sensors and the tracking unit may be one-way (i.e., sensor to tracking unit) or two-way. Multiple sensors may communicate with each tracking unit. (Welles, Abstract)

However, while Welles teaches the use of sensors to *monitor* cargo, the only thing that is actually stored in a memory of a device that accompanies the cargo in Welles system is a serial number stored in an **EPROM** of a sensor's microcontroller. Welles, column 5, lines 57-67. This serial number, which is used to track high value goods, is not in any way commensurate with "a data file comprising at least the following item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment," as recited in claim 1.

While the Office relies on the teachings of Pipinsure to allegedly teach aspects of claim 1, the Office does not cite the teachings of Pipinsure in regard to the specific claim aspects of i) generating a data file comprising at least the following item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment, and ii) storing the data file in a memory device that accompanies the item during said shipment, as recited in claim 1. Nevertheless, Applicant notes that Pipinsure does not in anyway overcome the deficiencies of Harrell and Welles in regard to these aspects of Applicant's claim. Pipinsure teaches potential savings for aggregate insurance needs (not a specific insurance policy) based on estimated aggregate shipping habits (as described in more detail below). Nothing within Pipinsure, even when considered in combination with Harrell and Welles, teaches or suggests the generation of the specific type of data file claimed (e.g., a data file that includes the claimed insurer information and the claimed item information) and storing that specific type of data file within a memory device that accompanies an insured item during shipment. These aspects of claim 1 are neither taught by nor suggested by the teachings of the cited art.

**2. Furthermore, the cited art fails to teach or suggest searching a database to select particular insurance for the item according to one or more**

**insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment.**

The Office cites pages 2, 8 and 9 of Pipinsure with respect to this limitation. Pipinsure discloses a series of questions a user can answer to “request a free quote on your package insurance needs.” The questions pertain to *general characteristics* of a user’s shipping *habits* including *average* number of packages insured per day and *average* value per insured package. **The whole point of the Pipinsure reference is to provide a customer with a *savings quote* based on *aggregate shipping characteristics*.** **The Pipinsure reference, considered singly or in combination with the other cited references, does not actually teach or suggest selecting *particular* insurance for an item during shipment from an origination to a final destination.** Moreover, Pipinsure certainly does not teach *searching a database* to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment. The teachings of Harrell and Welles fail to overcome the deficiencies of Pipinsure with respect to this claim limitation. Neither Welles’ sensor-based monitoring system nor Harrell’s method for obtaining marine cargo insurance teach or suggest any thing at all about searching a database to select particular insurance according to the specific limitations of claim 1.

In the response to arguments section of the Office Action of December 7, 2010 (page 12), the Office asserts that Pipinsure “suggest[s] a particular insurance for shipment of an item” and “suggest[s] the availability of different policies.” However, irrespective of the correctness of the Office’s assertions, the Office has not demonstrated that the cited art actually teaches or suggests “searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment,” as recited in Applicant’s claim. In no way are the general concepts of “suggest[ing] a particular insurance for shipment of an item” and/or “suggesting the availability of different policies” commensurate with the more specific aspect of Applicant’s claim that recites “searching a database to select particular insurance for the item according to one

or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment.” Applicant respectfully reminds the Office that “[d]istilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’” *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 1984.

**3. The cited art fails to teach or suggest accessing the memory device during or subsequent to said shipment from the origination to the final destination, and providing a notification to the insurer specified by the insurer information of said data file stored in the memory device in regard to damage that occurred during said shipment, as recited in claim 1.**

In regard to these aspects of Applicant’s claim, the Office cites column 6, lines 24-42 of Welles, which is reproduced below.

A customer requests the type of service desired by communicating with the central station. Based on the type of service requested, the central station transmits a message to the tracking unit carded by the container that places the tracking unit into the operational mode that will provide the requested services for the duration of the shipment. One mode of operation might be to monitor all transmitted temperature signals. If any cargo temperature should rise above or fall below the thresholds supplied by the customer, an immediate or a scheduled report of this fact is made, as determined by customer request. Another mode of operation might be to tally all cargo serial numbers within a container and report them to the central facility when the container starts moving (e.g., at initiation of shipment). Whenever the cargo serial numbers should happen to stop being reported, their removal from the internal tally would also be reported. This would allow the central station to provide computerized tracking of individual pieces of cargo to shippers or receivers on a real-time basis.

This portion of Welles pertains to monitoring temperatures and changes in the serial numbers within a container during shipment. **Welles fails to mention anything at all about insurance, much less providing a notification to the insurer specified by the insurer information of said data file stored in the memory device in regard to damage that occurred during said shipment.** Nothing about monitoring temperatures

and changes in the serial numbers within a container during shipment is commensurate with these aspects of Applicant's claim. **In fact, as described above, the only thing that any of the cited art references teach as being stored within a memory device that accompanies an item during shipment is the serial number of Welles.** Welles, column 5, lines 57-67. Accordingly, the cited references, even when combined, fail to teach providing a notification to the insurer specified by the insurer information of said data file stored in the memory device in regard to damage that occurred during said shipment.

**4. The Office Action failed to provide a clear articulated reasoning with rational underpinning to support a *prima facie* case of obviousness.**

On page 3 of the instant Office Action, the Office asserts Harrell, Pipinsure and Welles would have been combined to "include in the online insurance quoting system of Harrell the ability to provide lower cost shipping and insurance as taught by Pipinsure and monitoring the shipment via sensors as taught by Welles." However, Applicant does not claim "include[ing] in the online insurance quoting system ... the ability to provide lower cost shipping and insurance ... and monitoring the shipment via sensors...." In order for the office to demonstrate that a *prima facie* case of obviousness has been established, the Office would at a minimum have to demonstrate that the references would be combined in a way that is actually commensurate with Applicant's specific claimed invention. **It is not sufficient for the Office to demonstrate that the references may be combined to achieve some general objective. Instead, the Office must actually provide clear, articulated reasoning as to how combining the teachings of the cited references would actually result in the specific aspects of Applicant's claim.** Applicant respectfully reminds the Office that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (emphasis added). *KSR v. Teleflex*, 550 U.S. 398 (2007), 82 USPQ2d 1385, 1396. Moreover, as noted in MPEP 2142, "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed

invention would have been obvious.” Because the instant Office Action appears to be completely void of this specific type of reasoning (as noted in *KSR* and described in MPEP 2142), Applicant asserts the Office has not established a *prima facie* case of obviousness with respect to claim 1.

**5. Furthermore, combining the references in the manner suggested by the Office would not result in Applicant’s claimed invention.**

On page 3 of the instant Office Action, the Office asserts that the references would have been combined “since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.” Applicant asserts the Office’s assertion that the “claimed invention is merely a combination of old elements” is incorrect. In fact, Applicant has demonstrated above that the cited art is clearly deficient with respect to multiple aspects of Applicant’s claim. In one example, the only thing that any of the cited art references teach as being stored within a memory device that accompanies an item during shipment is the serial number of Welles. Accordingly, the cited art clearly fails to teach or suggest *i) generating a data file comprising at least the following item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment, and ii) storing the data file in a memory device that accompanies the item during said shipment.* As the cited art references fail to teach these and other aspects of claim 1, merely combining the references in way that the cited elements of each reference “merely would have performed the same function as it did separately” would not in any way result in Applicant’s claimed invention. In fact, because the cited references fail to teach multiple aspects of Applicant’s claim (as described above), combining the references in way that the cited elements of each reference “merely would have performed the same function as it did separately” would, by definition, not teach or suggest the entirety of Applicant’s claim.

6. Furthermore, the Pipinsure reference has not been shown to be prior art to the present application.

The Office relies on the Internet Archive Wayback Machine for a prior art date. The URL date indicated by the Internet Archive Wayback Machine is nothing more than a third party assertion. A publication date cannot be established based on an uncorroborated third party assertion unsupported by any affidavit or declaration. If all that was required to establish a publication date was a third party assertion unsupported by any affidavit or declaration, then any reference could be turned into prior art merely by finding a third party willing to place a prior publication date on the document. Such uncorroborated third party assertions unsupported by any affidavit or declaration are not sufficient evidence. If an Applicant wishes to submit an assertion by a third party as evidence, e.g., in support of a Rule 131 or 132 submission, then the third party assertion is required to be supported by an affidavit or declaration. The Office should be held to no less of a standard. Here, the Office has not obtained any affidavit or declaration from the Internet Archive Wayback Machine supporting the publication date of the Pipinsure reference. Nor has any other corroborating evidence been supplied by the Office despite repeated challenges by the Applicant. The Office has had ample opportunity to provide corroborating evidence, but failed to do so.

An uncorroborated third party assertion unsupported by any affidavit or declaration is not sufficient to establish a publication date, especially when the third party's own terms of use (<http://www.archive.org/about/terms.php>) state:

You understand and agree that the Archive makes no warranty or representation regarding the accuracy, currency, completeness, reliability, or usefulness of the content in the Collections, that the Site or the Collections will meet your requirements, that access to the Collections will be uninterrupted, timely, secure, or error free, or that defects, if any, will be corrected. We make no warranty of any kind, either express or implied.

Since, per its own terms of use, the Internet Archive Wayback Machine is not necessarily accurate, current, complete, reliable, secure or error-free, and since no

affidavit or declaration has been obtained from this third party to support the assertion, or any other corroborating evidence, a prior publication date has not been reliably established. Thus, Appellants assert that the Pipinsure reference has not been shown to be prior art.

In the response to arguments section of the instant Office Action (page 12), the Office refers to the propriety of relying on a web page per MPEP 2128. However, MPEP 2128 is assuming that such sources have been reliably established to have a prior date of publication. The Office seems to miss the point that, per the explicit terms of use for the Internet Archive Wayback Machine, the year 2000 archive is not guaranteed to be accurate, current, complete, reliable, secure or error-free. Nor is the year 2000 guaranteed to be an accurate date of when the archive was stored. In other words, the Internet Archive does not guarantee that the data listed for the year 2000 is what was actually archived or if anything was even archived at all on that date. Nor has any affidavit or declaration been obtained from the third party Internet Archive Wayback Machine to support the year 2000 date. Nor has any other corroborating evidence been presented. Thus, it cannot be said that Pipinsure has been established as prior art. The statute clearly places a burden of proof on the Patent Office which requires the Office to produce a factual basis for his rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). An uncorroborated third party assertion unsupported by affidavit or declaration, **and self-proclaimed to not necessarily be accurate**, cannot be said to have met the Office's burden of proof. It is the Office, not the Applicant, who shoulders the burden of proof in this regard.

Thus, for at least the reasons presented above, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested.

**Claim 1 – Harrell in view of Pipinsure in view of Welles in further view of Bennett**

In the instant Office Action (page 7), the Office rejected claim 1 as allegedly being unpatentable over Harrell in view of Pipinsure in view of Welles in further view of Bennett. With respect to this rejection, Applicant asserts that the cited art is deficient for at least the reasons presented above with respect to the deficiencies Harrell, Pipinsure, and Welles. Furthermore, Applicant asserts that Bennett fails to overcome the deficiencies of Harrell, Pipinsure and Welles.

More specifically, Bennett teaches an “apparatus, systems and methods that apply to a single particular billing method selected by each of a plurality of users, in response to each particular user's request, a set of billing method rules for each carrier of a plurality of carriers and determines whether or not each carrier of the plurality of carriers supports the shipper's specified preferred billing method, and if so, any special pricing considerations for each particular Carrier.” Bennett, Abstract. However, Bennett's system fails to overcome each of the deficiencies described above with respect to the Harrell, Pipinsure and Welles rejection of claim 1. For instance, as noted above, the only thing that any of the Harrell, Pipinsure and Welles references teach as being stored within a memory device that accompanies an item during shipment is the serial number of Welles; Bennett fails to overcome this deficiency as Bennett also fails to mention anything at all about *i) generating a data file comprising at least the following item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment, and ii) storing the data file in a memory device that accompanies the item during said shipment.* Likewise, as Bennett (even when considered in light of the other cited references) fails to teach or suggest these aspects of claim 1, by extension Bennett and the other cited references also fail to teach or suggest accessing the memory device during or subsequent to said shipment from the origination to the final destination, and providing a notification to the insurer specified by the insurer information of said data file stored in

the memory device in regard to damage that occurred during said shipment, as recited in claim 1.

Thus, for at least the reasons presented above, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested.

**Claim 1 – Harrell in view of Pipinsure in view of Welles in further view of Keplar**

In the instant Office Action (page 10), the Office rejected claim 1 as allegedly being unpatentable over Harrell in view of Pipinsure in view of Welles in further view of Keplar. With respect to this rejection, Applicant asserts that the cited art is deficient for at least the reasons presented above with respect to the deficiencies Harrell, Pipinsure, and Welles. Furthermore, Applicant asserts that Keplar fails to overcome the deficiencies of Harrell, Pipinsure and Welles.

More specifically, Keplar teaches “A system for sampling air contained in an appliance shipping container includes a gas analyzer sealably interconnected with a probe by a flexible conduit.” Keplar, Abstract. However, Keplar’s system fails to overcome each of the deficiencies described above with respect to the Harrell, Pipinsure and Welles rejection of claim 1. For instance, as noted above, the only thing that any of the Harrell, Pipinsure and Welles references teach as being stored within a memory device that accompanies an item during shipment is the serial number of Welles; Keplar fails to overcome this deficiency as Keplar also fails to mention anything at all about *i) generating a data file comprising at least the following item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment, and ii) storing the data file in a memory device that accompanies the item during said shipment.* Likewise, as Keplar (even when considered in light of the other cited references) fails to teach or suggest this aspect of claim 1, by extension Keplar and the other cited references also fail to teach or

suggest accessing the memory device during or subsequent to said shipment from the origination to the final destination, and providing a notification to the insurer specified by the insurer information of said data file stored in the memory device in regard to damage that occurred during said shipment, as recited in claim 1.

Thus, for at least the reasons presented above, the rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested.

### **Claims 19 and 20**

The rejection of claims 19 and 20 is not supported by the cited art for at least reasons presented above with respect to claim 1.

Furthermore, the Office Action failed to state a *prima facie* rejection of claims 19 and 20 because the Office Action failed to address specific limitations of 19 and 20. For instance, claim 19 recites "search a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides maximum insurance coverage for the item during said shipment for the least cost" (claim 20 includes a similar limitation). The Office Action rejected claims 19 and 20 for under the rationale used to reject claims 1, 2 and 6 (see page 6 of December 7, 2009 Office Action). However, claims 1, 2, and 6 are not commensurate with the aforesaid claim limitation of claim 19. None of claims 1, 2 and 6 recite "search a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides *maximum* insurance coverage for the item during said shipment for the *least* cost." Accordingly, the Office Action failed to state a *prima facie* rejection of claims 19 and 20. Nor does the cited art teach or suggest the aforesaid limitation of Applicant's claim.

In the response to arguments section of the instant Office Action, the Office cites page 8 of the Pipinsure reference and asserts "Pipinsure provides a data field in which a user may input the highest insured value of any package when request a quote for

package insurance.” This is the same argument that the Office put forth in the Advisory Action of February 22, 2010. As Applicant has already asserted and as demonstrated above, the user is not requesting a quote *for package insurance* in Pipinsure. Instead, the form fields of Pipinsure are fields for providing general shipping habits in order to obtain a *savings quote*. **The Office has failed to provide any substantive response to this specific argument.**

#### **Dependent Claims**

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time. Applicant reserves the right to present additional arguments.

## CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00901/RCK.

Respectfully submitted,

/Robert C. Kowert/  
Robert C. Kowert, Reg. #39,255  
Attorney for Applicant

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8850

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